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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,448	03/05/2000	Moses M. David	55436USA6A	6966

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EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 11/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,448

Applicant(s)

DAVID ET AL.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

The disclosure is objected to because of the following informalities: Page 12 lines 30+ and page 17 lines 19+ reference US application but fail to include the serial numbers. Applicant is encouraged to further review the specification for other instances of this type of omissions that was overlooked by the Office.

Appropriate correction is required.

The attempt to incorporate subject matter into this application by reference to 09/519,449 is improper because the specification does not teach the existence of this application. Additionally, the application should use the language "incorporating by reference" when referencing such an application.

The amendment filed 9/18/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has not identified the applications and "incorporated by reference" the subject matter which they may contain.

Applicant is required to cancel the new matter in the reply to this Office Action.

Newly submitted claims 31-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: In paper 7 a restriction requirement was made between microfluidic devices and a method of manufacturing. New claims 31-32 are similarly directed to a method of manufacturing and are restricted for the same reasons.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 29-30 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Limitation directed to the transmissive characteristics of the film and wavelength region of 180-800 nm is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1, 19-22, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0885983 (referenced as EP hereafter).

EP teaches a method of coating with a diamond like nanocomposition. In column 3 lines 29+ the composition of the layer is described on a hydrogen free basis to be 36% Si, 17% O and 47% C which is indistinguishable from the instant claims. The coating is applied to an injection mold which has been read on the claimed fluid handling device.

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Claims 1-11,13-15,17-25 and 27-30 are rejected under 35 U.S.C. 102(b,b,e,e) as being clearly anticipated by WO 98/33948, WO 98/59089, EP 0963455 or Neerinck et al. (USP 6,228,471) respectively.

These references all teach the claimed diamond film coated on an object.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11,13-15,17-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilding et al., "Sun International Division, Comar Inc." or Kopf-Sill et al. in view of EP 0885983 (referenced as EP hereafter).

Wilding et al., "Sun International Division, Comar Inc." and Kopf-Sill et al. all teach microfluidic devices but are silent to the claimed diamond like glass film coating.

See EP supra.

EP teaches a diamond like glass film coating indistinguishable from that claimed. In column 3 lines 32+ the coating displays a low surface energy, a high hardness, good tribiological properties, creates a non-stick coating and a controlled heat and/or electricity conductivity. It would have been within the skill of the art to modify over Wilding et al., "Sun International Division, Comar Inc." or Kopf-Sill et al. in view of EP to gain the above advantages.

Response to Arguments

Applicant's arguments filed 9/18/02 have been fully considered but they are not persuasive.

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Applicants' 9/18/02 amendments to the specification have not been entered because the specification does not reference the applications intended to be incorporated by references.

Applicant states EP 0856592 fails to teach the claimed coating having 30% C, 25% Si and less than 45% O. The Office directs Applicant to column 3 lines 7+ that teach these ratios. Applicants further state EP 0856592 fails to teach a fluid handling device. In the absence of better defining what is intended by this term, the Office maintains it is sufficiently broad to be read on the art of record.

Applicants remarks and amendments were sufficient to overcome the 35 USC 112 issues of paper 11. However, new 112 1st paragraph issues have been raised above.

Applicants remarks concerning EP 0885983 were convincing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Lyle A Alexander
Primary Examiner
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